REMARKS

I. General

Claims 1-22, 24-28 and 30-44 were pending in the present application. The present Office Action (mailed July 24, 2009) raises the following issues:

- Claims 1-22, 24-28, and 30-44 are rejected under 35 U.S.C. §112, first paragraph;

- Claims 1-21 and 37-41 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter;

- Claims 1-22, 24-28, and 30-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-36 of co-ending application serial no. 10/726,423;

- Claims 1, 2, 4-6, 8-10, 13, 14, 16, 17, 19-22, 24, 26-28, 38, 40, and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0199765 to Kohane et al. (hereinafter "*Kohane*" in view of U.S. Patent No. 6,363,486 to Knapton, III (hereinafter "*Knapton*");

- Claims 30-33, 37, 39, and 41-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of U.S. Patent Application Publication No. 2003/0074564 to Peterson (hereinafter "*Peterson*");

- Claims 3, 7, 18, and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of U.S. Patent No. 6,789,195 to Prihoda (hereinafter "*Prihoda*");

- Claims 11, 12, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of U.S. Patent Application Publication No. 2004/0068650 to Resnitzky (hereinafter "*Resnitzky*");

- Claim 34 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Peterson* and *Prihoda*; and

- Claims 35 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Peterson* and *Resnitzky*.

Applicant respectfully traverses the outstanding rejections raised in the current Office Action, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

II. Amendments

Claims 1, 16, and 37 are amended herein.

Claim 1 is amended to specify that the datastore is "residing on a data storage device". No new matter is introduced by this amendment as support can be found at least at paragraphs 0018-0019 of the specification. This amendment is intended to overcome the issue raised in the current Office Action regarding the recited datastore, and is believe to ensure that claim 1 is properly directed to statutory subject matter by tying it to a machine.

Claim 16 is amended to recite "wherein said key organization system comprises a processor-based computer". No new matter is introduced by this amendment as support can be found at least at paragraphs 0018-0019 of the specification. This amendment is intended to overcome the issue raised in the current Office Action regarding the recited key organization system, and is believe to ensure that claim 16 is properly directed to statutory subject matter by tying it to a machine.

Dependent claim 37 is similarly amended to recite "wherein said key organization system comprises a processor-based computer".

III. Rejections Under 35 U.S.C. §112, First Paragraph

Claims 1-22, 24-28, and 30-44 are rejected under 35 U.S.C. §112, first paragraph. The Office Action contends that the claims contain subject matter which was not sufficiently described in the specification. However, the only limitation which the Office Action expressly identifies as allegedly not sufficiently described in the specification is "wherein input of the second-level access key by said medical service provider is not required", *see* page 2 of the Office Action. Applicant respectfully notes that this limitation (or a similar limitation) is recited only in claims 30, 39, 41, and 43. Thus, the Office Action fails to establish any basis or provide any reasoning as to why the others of claims 1-22, 24-28, and 30-44 stand rejected under 35 U.S.C. §112, first paragraph. Further, as discussed below, Applicant respectfully contends that the recited limitation of claims 30-39, 41, and 43 is fully supported by the specification so as to reasonably convey to one of ordinary skill in the art that the inventor(s) had possession of the claimed invention at the time the application was filed.

The specification clearly describes exemplary embodiments in which a medical service provider is not required to input an access key that grants access to a patient's corresponding medical records. Rather, an exemplary key management system is described which associates access keys with a medical service provider for whom the keys have been granted, and then when the medical service provider logs in to the key management system, the medical service provider is presented with a list of patients who have granted the medical service provider an access key. The medical service provider may then access a patient's medical records by selecting the patient from the list, wherein a record processing module of the system uses the corresponding access key that the patient granted the medical service provider (rather than requiring the medical service provider to input such access key) for controlling the access rights by the medical service provider to the patient's medical records. For instance, paragraphs 0035-0037 of the specification explain an exemplary embodiment as follows:

> [0035] … Typically, medical service provider 18 logs into key organization system 10 using an encrypted SSL (i.e., secure sockets layer) connection.

[0036] Referring also to FIG. 6, when accessing key organization system 10, record processing module 58 provides the medical service provider 18 with a rendered screen display 158 that includes a list of patient identifiers 160. Patient identifiers 160 define the particular patient(s) who provided access keys to medical service provider 18 (i.e., granting medical service provider 18 access to various portions of their medical record(s))….

[0037] The presence of each of these names in the list of patient identifiers 160 indicates that a key was received from that patient. In order to access the medical record of a patient for which the medical service provider has an access key (i.e., for one of the patients listed in the list of patient identifiers 160), the medical service provider 18 selects the appropriate identifier using a mouse pointer 162 (or some other pointing device, not shown). For example, if the medical service provider wanted to access the medical record of Timothy Smith (i.e., patient 22), medical service provider 18 would typically double click (using a mouse) on the specific identifier 164 associated with Timothy Smith. Record processing module 58 would then, in turn, use access key 14 to access (i.e., retrieve, decrypt, and display) medical record 62, the medical record of Timothy Smith, i.e., patient 22. (Emphasis added).

Clearly, at least the above portion of the specification describes an exemplary embodiment in which a medical service provider is not required to input an access key that controls access rights for a patient's medical records, but instead a record processing module (58) uses the access key that is associated with the medical service provider for a patient selected by the medical service provider (without requiring the medical service provider himself/herself to enter the access key – instead, the medical service provider is described in the above example as simply selecting the patient whose medical records the medical service provider desires to access (e.g., by double clicking on the corresponding patient identifier).

Thus, for at least this reason, the rejection under 35 U.S.C. §112, first paragraph should be withdrawn.

IV. Rejections Under 35 U.S.C. §101

Claims 1-21 and 37-41 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claim 1 is amended herein to recite that the datastore is "residing on a data storage device". This is believed to resolve the issue raised by the current Office Action regarding the datastore, and is believed to ensure that claim 1 is directed to proper statutory subject matter because it is tied to a machine (i.e., the data storage device). As such, the rejection of claim 1 and the claims depending therefrom should be withdrawn.

Independent claim 16 is amended herein to recite "wherein said key organization system comprises a processor-based computer". This is believed to resolve the issue raised by the current Office Action regarding the recited key organization system, and is believed to ensure that claim 16 is directed to proper statutory subject matter because it is tied to a machine (i.e., the processor-based computer). As such, the rejection of claim 16 and the claims depending therefrom should be withdrawn.

V. Provisional Nonstatutory Obviousness-type Double Patenting Rejections

Claims 1-22, 24-28, and 30-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-36 of co-ending application serial no. 10/726,423 (hereafter "the '423 application"). Applicant respectfully submits that the rejection should be withdrawn to allow the present application to advance to allowance for the reasons discussed below.

First, it appears that because the provisional double patenting rejection should be the only issue remaining in the present application (as all other rejections are believed to be traversed for the reasons presented herein), the provisional double patenting rejection should be withdrawn to allow the present application to issue without requiring a terminal disclaimer. For instance, M.P.E.P. §804(I)(B)(1) explains:

> If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejetcion is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Here, the present application is the earlier-filed application, having a filing date of December 3, 2003, while the '423 application has a filing date of March 9, 2004. Therefore, it appears that the Examiner should withdraw the provisional obviousness-type double patenting rejection for the present application, and allow any such obviousness-type double patenting issues that may persist in the claims of the '423 application to be resolved during prosecution of that application.

In addition, Applicant notes that the Examiner has failed to establish a prima facie case to support the ground of obviousness-type double patenting. An obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims. Importantly, the rejection should also explain the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent. M.P.E.P. § 804(II)(B)(1).

In this case, Applicant respectfully points out that the Examiner has not articulated sufficient reasoning why a person of ordinary skill in the art would conclude that the pending claims are an obvious variation of the claims of the '423 application. *See* the Office Action of July 24, 2009 at pgs. 5-7. While the Office Action makes conclusory statements that certain limitations of the claims of the present application are "equivalent" to certain limitations in the claims of the '423 application, the Office Action offers no explanation or support as to why the claims of the present application, when read as a whole, are believed to be an obvious variant from the claims of the '423 application. As one example, claim 1 of the present application recites "generating a second-level access key by the patient modifying the level of access of the first-level access key", and the Office Action does not identify any claim in the '423 application that recites (or renders obvious) modifying the level of access of a first-level access key for generating a second-level access key. Therefore, the Examiner has not properly established a prima facie case of obviousness-type double patenting for the present application.

For the reasons above, Applicant respectfully requests that the rejection of claims 1-22, 24-28, and 30-44 be withdrawn to allow the present application to advance to allowance.

VI. Rejections Under 35 U.S.C. §103

A. Rejections under 35 U.S.C. §103 over *Kohane* in view of *Knapton*

Claims 1, 2, 4-6, 8-10, 13, 14, 16, 17, 19-22, 24, 26-28, 38, 40, and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane*" in view of *Knapton*.

Independent Claim 1

Claim 1 recites in part "maintaining, in a datastore residing on a data storage device a first-level access key that grants, to a medical service provider, a level of access to a set of medical records of a patient; ... and generating a second-level access key by the patient modifying the level of access of the first-level access key". The Office Action cites (on page 8 thereof) to Fig. 2B of *Kohane* as disclosing the recited datastore, and thus appears to contend that the credentials (39) of *Kohane* constitute the recited first-level access key. The Office Action concedes (at page 8 thereof) that *Kohane* fails to teach or suggest generating a second-level key by modifying the level of access of the first-level key. However, the Office Action introduces *Knapton* and contends that *Knapton* discloses this limitation. Applicant respectfully disagrees for the reasons discussed below.

Knapton discloses (in its abstract):

> Controlling the usage of a software component by an application program in an end user computer system includes obtaining an identifier of the application program by a controller computer system and generating a first password from the received application program identifier and an identifier of the component. The component, the component's identifier and the first password are communicated to the end user computer system. The component is registered with the application program as a "snap-in" or "plug-in" component. The application program generates a second password from the application program identifier and the received component identifier, compares the first password and the second password, and allows use of the "snapped-in" component by the application program on the end user computer system when the first password matches the second password.

The Office Action cites to col. 2, lines 24-43 of *Knapton*, which provide:

An embodiment of the present invention is a method of generating a password for controlling usage of a software component by an application program. A first key is created from an identifier of the application program, a second key is created from an identifier of the component, and the password is created from the first and second keys.

Another embodiment of the present invention is a method of controlling the usage of a software component with an application program in a computer system. The method includes obtaining an identifier of the application program and generating a first password from the application program identifier and an identifier of the component. The method also includes registering the component with the application program, generating, by the application program, a second password from the application program identifier and the component identifier, comparing the first password and the second password; and allowing use of the component with the application program on the computer system when the first password matches the second password.

It appears that *Knapton* does not address access keys that grant a medical service provider a level of access to a set of medical records of a patient. Instead, *Knapton* merely addresses passwords that control use of software components by an application program.

Further, *Knapton* does not generate a second-level access key (or password) by modifying the level of access of a first-level access key (or password). *Knapton* mentions generating a password from a first key created from an identifier of the application program and from a second key that is created from an identifier of the component. If the password is deemed an "access key", it is not generated by modifying a level of access of another password. In addition, neither of the first key and second key appear to correspond to any level of access, but instead appear to be based on an identifier of an application program and software component.

Knapton further mentions generating a first password from the application program identifier and an identifier of the component, and generating a second password from the application program identifier and the component identifier. While this mentions generating a first and second password, it does not teach or suggest generating the second password by modifying the level of access of the first password. Instead, both the first and second passwords are generated in *Knapton* from the application program identifier and component identifier.

In view of the above, the applied combination of *Kohane* and *Knapton* fails to teach or suggest all limitations of claim 1, and therefore the rejection of claim 1 should be withdrawn.

Independent Claim 16

Independent claim 16 recites in part "generating, by the key organization system, a second-level access key by modifying the level of access of the first-level access key, said second-level access key granting, to a second medical service provider, a second level of access to the set of medical records of the patient". The applied combination of *Kohane* and *Knapton* fails to teach or suggest at least this limitation for reasons similar to those discussed above with claim 1. Therefore, the rejection of claim 16 should likewise be withdrawn.

Independent Claim 22

Independent claim 22 recites in part "generate a second-level access key by modifying the level of access of the first-level access key". The applied combination of *Kohane* and *Knapton* fails to teach or suggest at least this limitation for reasons similar to those discussed above with claim 1. Therefore, the rejection of claim 22 should likewise be withdrawn.

Dependent Claims

Each of dependent claims 2, 4-6, 8-10, 13, 14, 17, 19-21, 24, 26-28, 38, 40, and 44 depends either directly or indirectly from one of independent claims 1, 16, and 22, and thus each inherits all limitations of the respective independent claim from which it depends. It is respectfully submitted that dependent claims 2, 4-6, 8-10, 13, 14, 17, 19-21, 24, 26-28, 38, 40, and 44 are allowable not only because of their dependency from their respective independent claim for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compels a broader interpretation of their respective independent claim).

B. Rejections under 35 U.S.C. §103 over *Kohane* in view of *Knapton* and *Peterson*

Claims 30-33, 37, 39, and 41-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Peterson*. Applicant respectfully disagrees for the reasons discussed below.

Independent Claim 30

Claim 30 recites in part "receive, via said communication network, a request from said medical service provider to access the set of medical records of the patient; and responsive to said received request, use said second-level access key for granting said medical service provider the modified level of access to the set of medical records of the patient, wherein input of the second-level access key by said medical service provider is not required" (emphasis added).

The Office Action concedes that the combination of *Kohane* and *Knapton* fails to teach or suggest "wherein input of the second-level access key by said medical service provider is not required", *see* page 17 of the Office Action. However, the Office Action contends that *Peterson* discloses this limitation, and concludes that it would have been obvious to modify the teachings of *Peterson* within the combination system of *Kohane* and *Knapton* "to facilitate access in the event of emergency or urgent care situation." *See* pages 17-18 of the Office Action.

Peterson discloses a system in which either of two access keys may be used for accessing a patient's medical data. "Privacy is assured because no one can access the records without a 'key' or unique identifier, which are known only to the patient, and are not discoverable with knowledge of patient's name, social security number, telephone number or other nationally indexed information." *Peterson*, ¶ 0010. *Peterson* further describes such a key or unique identifier at paragraph 0012 as follows:

> An individual is assigned an identifier, which may be printed on a card or otherwise carried on the individual's person. The individual chooses a second, memorable, unique identifier for use when the card is not available. Entering either identifier provides immediate access to the records. No password is needed for viewing of the records, thereby facilitating access in the event of an emergency....

Thus, *Peterson* describes that either of the two access keys or unique identifiers assigned to the patient must be input in order to access the patient's medical records, but viewing access does not further require a password. *Peterson* describes in paragraph 0011 that: "Altering and updating the information requires use of a personal identifier plus a password, which is selected by the individual." Therefore, viewing of the medical records requires only input of one of the two access keys assigned to the patient, while editing of the medical records further requires input of a password in *Peterson*. In no event does *Peterson* not require a medical service provider to input an access key (e.g., unique identifier) for accessing the patient's medical records, *see e.g.,* paragraph 0010 of *Peterson* ("Privacy is assured because no one can access the records without a 'key' or unique identifier").

Claim 30 recites that a second-level access key is used for granting the medical service provider a modified level of access to the set of medical records, where input of such second-level access key by the medical service provider is not required. The Examiner contends that the credentials of table 22 of *Kohane* (as allegedly modified according to *Knapton*) constitute the recited second-level access key. If the system of *Peterson* were employed within *Kohane*, the credentials would include at least the access key (unique identifier) required to be entered by the medical service provider by *Peterson*.

Further, if neither the access key (unique identifier) nor the password of *Peterson* were required to be entered by the medical service personnel, then it appears that unrestricted access would be available to the patient's medical records. In that instance, the recitation by claim 30 of "use said second-level access key for granting said medical service provider the modified level of access to the set of medical records of the patient" (emphasis added) would not be satisfied because no second-level access key would be used.

Thus, for at least the above reasons, the applied combination of *Kohane*, *Knapton*, and *Peterson* fails to teach or suggest all limitations of claim 30. Therefore, the rejection of claim 30 should be withdrawn. Further, each of dependent claims 31-33 depends either directly or indirectly from claim 30, and are thus believed to be allowable at least for the reasons discussed above with claim 30.

Further claims 37 and 39 depends either directly or indirectly from independent claim 1, and are thus believed allowable at least for the reasons discussed above for claim 1.

Claim 41 depends from claim 16, and is thus believed to be allowable at least for the reasons discussed above with claim 16.

Claims 42-43 each depends either directly or indirectly from independent claim 22, and are thus believed to be allowable at least for the reasons discussed above with claim 22.

C. Rejections under 35 U.S.C. §103 over *Kohane* in view of *Knapton* and *Prihoda*

Claims 3, 7, 18, and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Prihoda*. These dependent claims are believed to be allowable at least based on their dependency from their respective independent claim for the reasons discussed above.

D. Rejections under 35 U.S.C. §103 over *Kohane* in view of *Knapton* and *Resnitzky*

Claims 11, 12, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Resnitzky*. These dependent claims are believed to be allowable at least based on their dependency from their respective independent claim for the reasons discussed above.

E. Rejection under 35 U.S.C. §103 over *Kohane* in view of *Knapton*, *Peterson*, and *Prihoda*

Claim 34 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Peterson* and *Prihoda*. This dependent claim is believed to be allowable at least based on its dependency from its respective independent claim for the reasons discussed above.

   F. Rejection under 35 U.S.C. §103 over *Kohane* in view of *Knapton*, *Peterson*, and *Resnitzky*

   Claims 35 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Peterson* and *Resnitzky*. These dependent claims are believed to be allowable at least based on their dependency from their respective independent claim for the reasons discussed above.

   VII. Conclusion

   In view of the above, Applicant believes the pending application is in condition for allowance.

   Applicant believes no fee is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 50-3948, under Order No. 66729/P033US/10614705 from which the undersigned is authorized to draw.

Dated: October 26, 2009   Respectfully submitted,
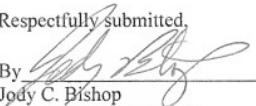
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